

REMARKS

Entry of the foregoing, re-examination and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claim 29 has been canceled and claim 1 has been amended at least partly in response to issues raised in the Office Action. Support for the amendment to claim 1 may be found on page 4, lines 6-8 of the specification. Newly added claims 40-43 are directed to subject matter which finds support on pages 14 and 15 of the specification. Claims 1, 2, 4, 5, 14, 16, 34 and 37-43 are currently pending in this application. Claims 14 and 37-39 stand withdrawn from consideration.

Claims 1, 2, 4, 5, 14-29 and 34 have been rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,800,914 to Shiokawa et al for the reasons set forth in paragraph (9) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

The presently claimed invention relates to a solid polymer electrolyte comprising at least one high mass or three-dimensional cross-linked methacrylonitrile homopolymer or copolymer. The term "Solid polymer electrolyte" is defined in the specification as comprising a polymer and a salt which may or may not be attached to the polymer. Note, for example, page 4, lines 6-8; page 14, lines 16-18; page 27, lines 3-6, etc. Accordingly, the language in the preamble of claim 1 necessarily gives "life, meaning and vitality" to the claim and is that which distinguishes over the cited art.

"The language in the preamble can limit the invention as a whole if it is necessary to give meaning to the claim in order to properly define the invention." See *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 U.S.P.Q. 669,675-76 (Fed. Cir. 1984) (cited *In re Bulloch*, 604 F.2d 1362, 1365, 203 U.S.P.Q. 171, 174 (C.C.P.A. 1979); *Kropa v. Robie*, 187 F.2d 150, 151-52, 88 U.S.P.Q. 478, 480-81 (C.C.P.A. 1951)); see also *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d at 866, 228 U.S.P.Z. at 92 (term "anaerobic" in preamble construed as limiting because it "breathes life and meaning into the claims"); *Corning Glass Works v. Sumitomo Plastics U.S.A.*, 868 F.2d 1251, 1257, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989). Note also the discussion in M.P.E.P. Section 2111.02 (Rev. 1, Feb. 2003). Thus, claim 1 as currently amended, now explicitly recites what was already implicit in the claim.

Shiokawa et al '914 is directed to the manufacture of thermal image transfer recording media which include a thermofusible thermoplastic resin. Suitable resins include methacrylonitrile copolymers. This document does not disclose solid electrolyte polymers as defined by the present claims.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.2d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); accord *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). Since Shiokawa et al '914 does not disclose a solid electrolyte polymer in accordance with the Applicants' invention, the reference fails as an anticipation.

For at least the above reasons, the §102(e) rejection over this reference should be withdrawn.

Claims 1, 2, 4, 5, 16 and 34 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,258,234 to Ide et al for reasons given in paragraph (10) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

Ide et al '234 is directed to the manufacture of thermal image transfer recording media which includes an ink layer containing acrylonitrile or methacrylonitrile copolymers. This document does not disclose or suggest that the copolymers are solid electrolytes, i.e., contain a salt. Accordingly, the §102(b) rejection over Ide et al '234 is inapplicable to the present claims.

For at least the foregoing reasons, the §102(b) rejection over this reference should be withdrawn.

Claims 1, 2, 4, 5, 16 and 34 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 3,873,493 to Labana et al for reasons set forth in paragraph (11) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

Labana et al '493 is directed to the preparation of reinforced thermoset resins. Suitable resins include methacrylonitrile/glycidyl methacrylate copolymers. The document does not disclose or suggest solid electrolyte polymers as defined in the present claims. Accordingly, Labana et al '493 is not anticipatory.

For at least the above reasons, the §102(b) rejection over this reference should be withdrawn.

Claim 29 was rejected under 35 U.S.C. §103(a) as unpatentable over any one of Shiokawa et al '914 or Ide et al '234 for reasons given in paragraph (12) of the Office Action. Also, claim 29 was rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 4,187,353 to Schroeder or U.S. Patent No. 3,931,123 to Vacik et al for reasons set forth in paragraph (13) of the Office Action.

Claim 29 has been canceled. Accordingly, the above rejections of the claim have been rendered moot.

In view of the above amendments and remarks, it is respectfully submitted that this application is now in condition for allowance. If there are any questions, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his/her earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:


George F. Lesmes
Registration No. 19,995

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: May 21, 2003